

the package is ~~developed~~.--

3
line
--16. A process according to Claim 10, wherein the second exposed portions of the several film items are not all identical.--

19-3869

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 19-3869.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 19-3869.

REMARKS

Support for the amendment for claims 1-3 & 5 is found in the claims as originally presented, and pages 2-5 of the specification, support for new claims 9-16 is in the specification at pages 2-5, specifically page 2 last paragraph.

Applicant acknowledges with appreciation the examiner's indication that the previous rejection has been withdrawn.

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments:

A. From page 2 of the Office Action.

With respect to claims 1-8, it is applicant's contention to claim a product. This has always been applicant's intention and, moreover, it is believed that this intention was fairly conveyed all along by the fact that claim 1 was drawn to "[a] sealed package of film". By the same token claims 2-8 depended directly or indirectly on claim 1 and were drawn to "[a] package". It is not believed that such claims being drawn to packages could be fairly considered to be anything other than product claims.

The confusion apparently has to do with the fact that claim 1 and some of the other claims contain recitations of intended use. It is not believed that such statements converted the product claims to process claims as a matter of law.

However, in order to advance the prosecution and in order to provide a crystal clear statement as to the intended coverage, the claims have been revised extensively above in a manner which it is believed leaves no doubt that the applicant intended claims 1-8 to cover any product meeting the terms of those claims.

Thus, claims 1-8 have been revised to exclude any rambling statements of intended use also, in order to clarify matters the term "film items" has been replaced by "exposable

photographic frames". Although the new term does not appear *ipsis verbis* in the specification, its use does not raise any issues of new matter in as much as it would have been clear to any person skilled in the art that this term is equivalent to what applicant intended by the term "film item". See In re Anderson 176 USPQ 331 (CCPA 1973).

For completeness it should be pointed out that the "photographic frame" of new claim 1 is different from the term "frame" from previous claim 2. The former relates, as any person skilled in the photographic art would appreciate, to individual portions of film designed to provide a composite picture. See for example Spector US Pat 4,994,832, abstract and Cols 1-2. The latter term is meant to refer to what is ordinarily ornamental surrounding of the picture. In other words according to the terms of claims 1 & 2 the invention relates to film comprising a plurality of photographic frames wherein each photographic frame comprises a first unexposed portion and a second exposed portion wherein the second exposed portion can surround the first unexposed portion essentially as a ornamental frame.

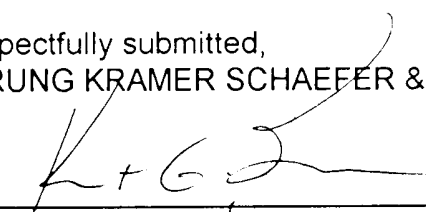
Applicant has also submitted process claims 9-16 which find support in the specification at pages 2-5, specifically page 2 last paragraph. These process claims are limited in scope to that of the present article claims 1-8. Applicant contends that since the article claims are novel and unobvious, the process of making the article, as a matter of law, are also novel and unobvious. See In re Ochiai 37 USPQ2d 1127 (CAFC 1995).

In the event that restriction is required between product and process claims, then Applicant elects the product claims. Applicant understands that if the product claims are allowed, then the Examiner must rejoin process claims of the same product scope. See the Commissioner's notice of February 28, 1996, published at 1184 OG 86 (March 26, 1996).

In view of the forgoing, applicant submits that this application is now in condition for immediate allowance. And early notice of allowance is therefore respectfully requested.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the United States Postal Services as first class mail in an envelope addressed to The Assistant Commissioner for Patents, Washington, D.C. 20231 on July 1, 1997.

SPRUNG KRAMER SCHAEFER & BRISCOE

Date July 1, 1997

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By